

No. 6011

IN THE
United States
Circuit Court of Appeals,
FOR THE NINTH CIRCUIT

WATERLOO REGISTER
COMPANY, a corporation,
Appellant,
vs.
CHARLES ATHERTON,
Appellee.

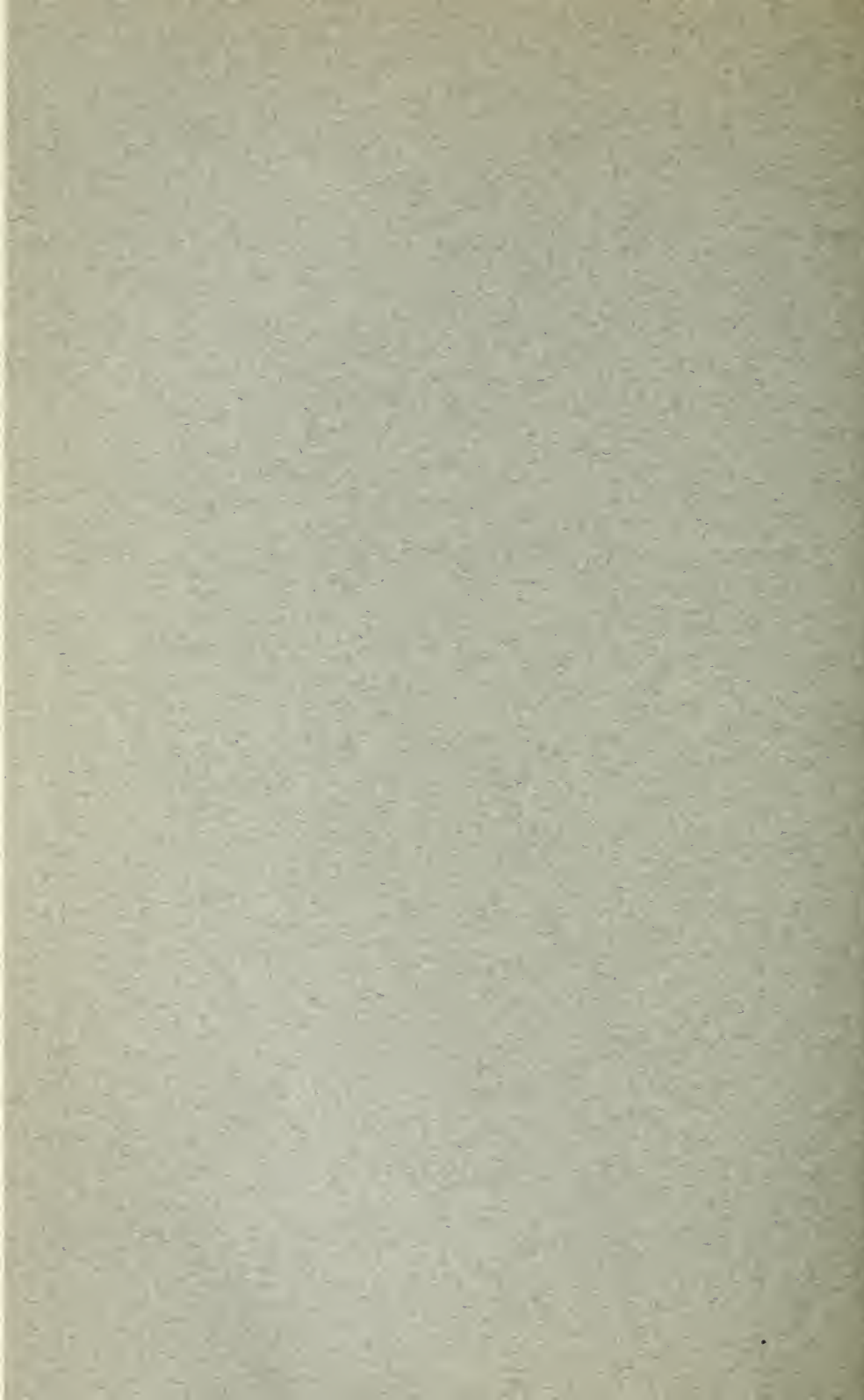
BRIEF ON BEHALF OF
APPELLEE

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BRIEF ON BEHALF OF APELLEE

Preliminary Statement

This is a suit in equity brought for the alleged infringement of the patent to William L. Carter, No. 1,601,469. After hearing the testimony taken in open court, and after a full consideration of the same in view of briefs filed by both parties, the Judge of the District Court rendered his decision in favor of the defendant and a decree was entered adjudging that the said defendant had not infringed the claims of said patent and, further, that the registers made by said defendant were in public use for more than two years prior to the filing of the application for said letters patent. (Tr. p. 21). The decree was

not, as stated on page 1 of appellant's brief, that the registers, "claimed as an invention in said letters patent and made by said defendant, were in public use." Such a decree, if it had been made, would have been inconsistent with the finding that the defendant had not infringed the claims of the patent.

For convenience, the appellant and appellee herein will be referred to as plaintiff and defendant respectively.

The Patent in Suit

The said Carter patent is for an air register for use in connection with heating furnaces. It comprises an outer rectangular frame 10, within which there is mounted an interior rectangular frame 12. Extending vertically across the opening in the latter frame are a series of rods 17 upon which the shutters 16 are pivoted. For the purpose of opening and closing the shutters simultaneously, they are connected together by a bar 21. For attaching this bar to the shutters, the latter are slit at one end and a portion is turned at right angles to form an ear 19 which is attached to the bar by a pin 20 (see Fig. 5). When this portion is thus bent, a shoulder 22 is left on the shutters, and this shoulder has the function of limiting the opening movement of the shutters by engagement with the bar.

The patent has two claims, both of which are alleged to be infringed. Both of these claims call specifically for "a rectangular frame, equi-distant rods secured thereto *and extending accross the opening therein*" and for the "shoulders *engageable by said bar* to limit the opening movement of the shutters."

As will be hereinafter pointed out, the testimony in this case shows conclusively that defendant, Atherton, never

made a register having either of these features. Further, it will be pointed out that plaintiff has not shown that it ever made or sold a single register having the rods extending across the opening in the frame. In other words, plaintiff has not shown that it has ever built registers under the patent in suit, notwithstanding the statement near the bottom of page 48 of its opening brief that it has "built up a business of manufacturing and selling its patented register amounting approximately to about \$200,000.00 a year, or grossly to about a million dollars since 1924."

Defendant's Bill of Particulars

On pages 11 to 13, inclusive, of its brief, plaintiff discusses certain parts of defendant's Bill of Particulars and argues therefrom that defendant has admitted the validity of the patent in suit and "has condemned himself out of his own mouth." This argument is based upon the assumption that defendant was referring in his Bill of Particulars to one of his exhibit registers, whereas, in fact, he was referring to another. The "said old register," referred to in the paragraph (b), is the old Hudson register which is Defendant's Exhibit B.

The part of plaintiff's brief which is based upon this error or misunderstanding on the part of appellant should be ignored. The bearing of Defendant's Exhibit A on the issue presented will be discussed hereinafter.

Plaintiff's Testimony in Chief

In its testimony in chief, plaintiff introduced the patent in suit, established its title and notice to defendant of his alleged infringement. It then introduced, through its witness Gilley (Tr. p. 31), a register (Plaintiff's Exhibit 7), which this witness said he had purchased at a store on the

day before he testified and that he was told by the salesman that it is an Atherton register. On cross-examination it developed that he had no personal knowledge whatever about this register. (Tr. p. 35).

Of course, this did not make out a *prima facie* showing of infringement, since it did not connect Atherton with the register in any way except by hearsay and it certainly did not show that Atherton had infringed the patent by making, using or selling the patented register prior to the commencement of the suit. However, defendant, desirous of having this case tried on its merits, did not object to the introduction of the said register and it was received as Plaintiff's Exhibit 7. Further, when Atherton was called as a witness in his own behalf, he frankly admitted that the said exhibit was his manufacture (Tr. p. 44) and that he had been making such registers since early in 1923 (Tr. p. 45). With this aid from defendant, plaintiff's *prima facie* case was established.

General Statement of Defenses Relied On

The defendant has shown by the testimony in this case, and will show by this brief, that he has done nothing which infringes the claims of the patent in suit or either of them; that if the said claims be construed so broadly as to make them apply to the register which he has made and sold, then the claims are invalid for the reason that the things which he has made and sold since the grant of the Carter patent in suit are identically the same in structure and operation as the things which he made and sold and which went into public use years before the patent was granted and years before the application for the patent was filed. Defendant will further show that the claims of the patent are invalid for the reason that they purport to cover a combination of

elements whereas they, in fact, call merely for an aggregation of independent and unrelated elements or features.

The Defense of Non-Infringement

In an attempt to show infringement, the plaintiff introduced its said Exhibit No. 7, which, as stated, Atherton later admitted was a register he had made. (Tr. p. 45). That exhibit is a portion only of a complete register. It consists of a frame within which there is a series of pivoted shutters. In the complete register, this frame with its shutters is mounted within an outer frame. *When the Atherton register is installed, it does not embody the subject-matter of the claims of the patent in suit for two reasons. First, it does not have the rods extending across the opening in the frame; and, second, it does not have shoulders formed on the respective shutters and engageable by the connecting bar to limit the opening movement of the shutters.* The Atherton register has short nails or pins at the ends of the shutters upon which the latter are pivoted, and the opening movement of the shutters is limited by the engagement of the end of the connecting bar with the outer frame. (Tr. p. 52). These differences between the structure covered by the patent and the Atherton register have always existed, since Atherton has never built his registers in any way other than as just stated. (Tr. pp. 52 and 53.)

This is a matter which is not disputed by plaintiff; but it is contended that these differences are meaningless subterfuges designed to evade the patent in suit (See Plaintiff's Opening Brief, pp. 16 and 19). It is submitted that this contention is without merit and is fatal to the validity of the patent in suit. The changes were not made to avoid

the patent, since Atherton's registers were in use long before Carter obtained his patent and long before Atherton knew of the plaintiff company (Tr. p. 60) or what said company was making or intending to make. If these changes or differences are meaningless subterfuges, as stated in Plaintiff's Brief, then the patent must necessarily fall because it has nothing to sustain it over the old Atherton structures except those so-called meaningless subterfuges. If that is all they amount to, then Carter made no invention at all, and his patent is necessarily invalid.

Prior Invention by Atherton Defendant's Exhibits A and B

Sec. 4886 of the Revised Statutes provides, in effect, that one may not obtain a patent for an invention or discovery if that invention had been known or used by others in this country before his invention or discovery thereof or had been in public use or on sale in this country more than two years prior to his application for patent.

Carter filed his application for the patent in suit on June 7, 1926; and there is nothing other than the bare statement of plaintiff's employee Gilley that Carter ever conceived this invention prior to the date when he filed his application therefor. That witness stated that the Waterloo Company began manufacturing registers like Plaintiff's Exhibit 6 in the fall of 1924. (Tr. p. 32). His testimony is not corroborated by anybody or by anything, and it is submitted that it is insufficient to establish the fact of this early manufacture. But, however that may be, Atherton had produced the register which he has since been manufacturing substantially a year and a half prior to this alleged manufacture on the part of the Waterloo Company and more than three years prior to Carter's application for patent. Therefore, in

view of Sec. 4886, above referred to, the Cater patent is invalid if the claims thereof be construed so broadly as to cover this prior invention of Atherton's.

Atherton has put in evidence, as "Defendant's Exhibit A," the first register of the general type here in issue which was made by him, and he has testified that he made this identical register in the beginning of 1923. (Tr. p. 46). Before making this register, Atherton had in his possession a register which he has produced in evidence and which has been marked "Defendant's Exhibit B." The testimony is that this old register was used on the front of the radiator of a Hudson automobile. (Tr. p. 48). *It has a fixed bar design when the shutters are open, and a panel effect when they are closed.* Originally, the shutters were pivoted upon equi-distant rods which extended across the opening in the register frame, as in the Carter patent. Atherton removed these rods and substituted the short studs or nails at the ends of the shutters. (Tr. p. 50). The old rods have been preserved and have been produced in evidence as "Defendant's Exhibit C."

This is the "old register" which is referred to in paragraph (b) of Defendant's Bill of Particulars. As will be noted, it originally had the frame, the series of rods extending across the opening in the frame to which the shutters were pivoted, said shutters forming a bar design when they were in their open position and a panel effect when they were closed. This old register differed from the register of the patent in suit in that it did not have the ears stamped out of the rear corner portion of each shutter nor did the shoulders formed by cutting out the ears engage with the connecting bar to limit the opening movement of the shutters. This is just as stated in the said Bill of Particulars.

It is the testimony of Atherton that he experimented with this old Hudson register (Tr. p. 64) and worked out some features which he embodied in his first register, Defendant's Exhibit A. (Tr. p. 51). *This register has the short pins or studs upon which the shutters are pivoted and thus embodies that change which Atherton made in the old Hudson register. In Exhibit A, the bar connecting the shutters is attached to ears which are stamped from the ends of the shutters much in the manner later adopted by Carter and shown and claimed in his patent. However, the shoulders which are formed by stamping out the ears do not engage with the connecting bar to limit the opening movement of the shutters.* (Tr. p. 52).

Atherton testifies that he showed his Exhibit A to Herbert Lindsay some time in April, 1923, with the idea of having Lindsay join him in the business of manufacturing them and a valve which Atherton had invented. (Tr. p. 53). Atherton and Lindsay then formed a partnership. (Tr. p. 54).

The witness Lindsay states that he saw Defendant's Exhibit A in or about April, 1923 (Tr. p. 90). This date was impressed upon his mind by reason of the fact that Atherton asked him to join with him in the manufacture of this register and of a certain valve which Atherton had invented. Lindsay did join Atherton, forming a partnership (Tr. p. 91; and, in the latter part of 1923, a certain tract of ground was purchased for the erection of a factory within which to manufacture those registers and the valves. At the trial, Mr. Lindsay produced the deed for this tract of land and the same was shown to counsel for plaintiff. (Tr. p. 91). The deed shows that the land was transferred in the latter part of 1923, much more than two years before Carter

filed his application for patent. Therefore, Atherton had made his Exhibit A and had shown the same to Lindsay some time prior to the purchase of this tract and more than two years before Carter filed his application for the patent in suit.

The testimony regarding the manufacture of Defendant's Exhibit A stands without contradiction notwithstanding the negative testimony of certain of plaintiff's witnesses to the effect that they had not seen the Exhibit in 1923. As to the witness Wysong, he admits that his duties were outside installation work (Tr. pp. 119 and 121) which kept him out of the shop or factory the greater part of his time, and that Atherton might have made a good many registers like Exhibit A without his knowledge. (Tr. p. 122). He further admits that Atherton may have had the machinery necessary for making the louvers. (Tr. p. 120). Wysong's testimony does not even tend to discredit Atherton.

The testimony of the witness Chester is as surprising as plaintiff's counsel advised the Court it would be. (Tr. p. 110). It is so inconsistent and conflicting that one can be certain of one thing; and that is, that Chester is so hostile and unfair and his testimony so conflicting that it can be given no weight whatever.

It appears that, in 1923, Chester was making an electric valve at 1174 East Colorado Street, Pasadena; that in January of that year he and Atherton formed a partnership (Tr. p. 110); that Atherton then had a sheet-metal shop of his own at 1164 East Colorado Street, Pasadena, and that Chester occasionally went into Atherton's shop. (Tr. p. 111). Chester does not say that Atherton did not have his Exhibit A in 1923, nor does he say that he did not see it at that time. In fact, he was asked nothing and he said

nothing about it except that he did not see Atherton working on it. (Tr. p. 117). His testimony is merely to the effect that Atherton did not have a two-ton press in his own shop. (Tr. p. 113) Then he admitted that Atherton did have a "Niagara No. 15" press in 1923, but he said that that press was in his (Chester's) shop. (Tr. p. 113). Atherton had previously testified (Tr. p. 63) that he had used "a two-ton press from the Niagara Machine Tool Company" in making his Exhibit A, and that the press was in his own shop. Therefore, the only point in dispute between Atherton and Chester is as to the location of that press.

When asked if Atherton did not take that press from his own shop and put it in Chester's, Chester admitted that he did; but he said that was in the fall of 1923 and that he could produce documents to prove that date. (Tr. p. 113). No such documents were produced. Of course, if the press was not moved until the fall of 1923, then it was in Atherton's shop in the early part of that year, just where Atherton had said it was.

Evidently puzzled over this testimony, since it clearly corroborated Atherton's, the Court took up the examination of the witness. Chester admitted that Atherton had "a big lever press" which he called a "Niagara," and that he moved it to Chester's shop "in the fall of the year, before we dissolved partnership." (Tr. p. 115). The said partnership was dissolved April 1, 1924. (Tr. p. 111). Again Chester testified positively that the press was moved "in the latter part of 1923." (Tr. p. 115). But at other times he said that in April, 1923 it was in his own shop (Tr. p. 115) and finally he said that, in the fall of 1923, Atherton moved it *out* of Chester's shop. (Tr. p. 115). Then he was asked by counsel if he meant that in the fall of 1923 Atherton

moved the press out of his own shop into Chester's, and this is the answer (Tr. p. 116):

“A. I suppose so. I don't know. I know the press stood right by the door and I stumbled over it all the time. He used it for his own use and punched out parts of the furnaces.”

That, of course, mixed up the matter still worse; but the Court stopped further attempts to straighten it out by saying:

“Well, he has testified. Arguing with him won't do any good.” (Tr. p. 116).

And so the record stands. It is submitted that Chester corroborates Atherton. He admits that Atherton had the Niagara press in the early part of 1923. If it was then in Atherton's shop, there is no difficulty whatever. But if it was then in Chester's shop, that makes no difference, since Atherton was Chester's partner and obviously could have used the press to make Exhibit A just as Chester says he used it to punch out parts of his furnaces. (Tr. p. 116).

Defendant's testimony respecting the manufacture of Exhibit A is clear and convincing, and it stands without a word which can raise a doubt as to its truthfulness. Therefore, it is unquestionably established that, more than two years before Carter filed his application for patent, defendant had perfected the register which allegedly infringes the patent in suit, and had formed a partnership to commercialize the register; that a factory site was purchased, a factory built and that defendant entered the market with his register. Defendant could safely rest his case on this testimony alone.

But it is pointed out that Atherton did not get his dies until about 1926, and from that it is argued that he did not make registers or louvers prior to that time. Atherton testified that, for the first two or three years, he made louvers for hot-air registers only when another type of register which he was handling could not be used. (Tr. pp. 54 and 67). Most of the louvers he made were 6 x 8 inches in size for use over stoves in kitchens for ventilators. When he had occasion to make a hot-air register he used the machinery he had on hand, and "they were hard to make up" (Tr. p. 67). It was not until the demand justified the expense that the dies were ordered. (Tr. p. 94).

Public Use and Sale—The Bossart Installation

Following the manufacture of Defendant's Exhibit A, Atherton made up some complete registers which were installed in various places about Los Angeles and Pasadena. After defendant had located one house in which these registers were installed in 1923, it was considered that the proof of such installations at that time and the continuous use of the registers thereafter would be sufficient to show prior public use and sale of his registers at a date more than than two years before Carter filed his application for the patent in suit. (Consolidated Fruit Jar Co. v. Wright, 94 U. S., 94; Egbert v. Lipmann, 104 U. S. 333). Consequently, defendant made no strenuous effort to locate additional installations.

The testimony is clear and conclusive that, in the first part of 1923, two of Atherton's registers were installed in the home of Mr. Emil Bossard, which is now at No. 13015 Chandler Boulevard, Van Nuys, California. Van Nuys is now a part of Los Angeles. One of these registers which was installed at that time is in this case as Defendant's Ex-

hibit D. It is a complete, well constructed, operative register which was in continuous use in Mr. Bossard's home from the date of its installation in 1923 until two days before the trial in this case, when it was removed from Bossard's home in the presence of Bossard, his wife, Atherton and Lindsay, each of whom inscribed his initials upon it in order that he might clearly identify it as being the register which was thus removed.

If the proof respecting the installation of this register in 1923, or at any time thereafter prior to June 7, 1924, is established, then plaintiff has no case whatever against Atherton; for, in that case, the register would have been in public use and on sale more than two years before Carter filed his application for patent, and the latter would be invalidated by that use and sale if the claims of the patent be construed so broadly as to cover this Exhibit D (Sec. 4886, R. S.). It is submitted that the testimony respecting this installation in 1923 is clear and conclusive.

Bossard and his wife both fixed the date as in or about May, 1923 (Tr. pp. 78 and 87), by reference to the purchase of their home where the registers were installed. (Tr. pp. 77 and 86). Atherton fixes the date by reference to the time when he formed his partnership with Mr. Lindsay (Tr. p. 54) which, as has been stated, was sometime prior to the purchase of the tract of land upon which the factory was to be erected, which purchase was in the latter part of 1923. Atherton further testifies that he made up the registers which were installed at the Bossard home to go with a special super-heater furnace which he made early in 1923. (Tr. pp. 59 and 67). This was the furnace which was sold to Bossard and Atherton never made another like it. (Tr. p. 67). The witness Lindsay also testifies that he had

knowledge of the installation of the Bossard registers in 1923. (Tr. p. 94).

Bossard is, himself, a furnace man and sheet-metal worker. (Tr. p. 73). He owned the place where these registers were installed. Under such circumstances, he did not consider it necessary for him to secure a permit to do this work upon his own home, and he did not take out a permit for that job. (Tr. p. 79).

The testimony of the plaintiff respecting the Bossard installation is based altogether upon speculation. Mr. Franklin, who saw the registers in the Bossard home (Tr. p. 101), made an inspection of the County records to see if he could find a permit which applied to the property located at 13015 Chandler Boulevard, Van Nuys, California. He turned up a permit which appears to have been issued May 14, 1925, (Tr. p. 98), and he now insists that this permit must be for the particular job which involved the installation of the registers in the Bossard home. Since the said permit did not identify the Bossard home, having been issued in the name of one George F. Martin as owner, and was for work to be done at 13015 East Sherman Way and not on Chandler Boulevard, objection to the admission of the permit on the ground that it was not connected up with the property in question was sustained.

It appears from the testimony that the Bossard home stands upon a large lot upon which another three-room house was built in 1926. (Tr. p. 73). In 1923 and up until this house was built, the Bossard home was numbered 13005, Chandler Boulevard. (Tr. pp. 73 and 84). Then this number was placed on the new three-room house

and the home place was given the present number, 13015. (Tr. p. 73). This was in 1926. Therefore, *in May, 1925, at the time the Martin permit was issued, there was no such place as 13015 Chandler Boulevard*. Bossard says he never had the number 13015 East Sherman Way, which appears to have been the place where the job of the Martin permit was to have been done. It is clear, therefore, that the permit which appellant produced at the trial had no connection with the installation of the Atherton registers at the Bossard home, and that *the trial Judge did not err* when he excluded it from the evidence.

It is submitted that defendant's evidence respecting the sale, the installation and public use (Tr. pp. 56 and 82) of the Bossard registers in 1923 is conclusive of that fact. One of the said registers is in evidence and there can be no doubt as to its mechanical structure and operation. The witnesses have testified definitely and positively that it was installed in 1923. *Bossard and his wife are entirely disinterested witnesses*. (Tr. p. 82). They bought their home where the registers were installed in 1922. That date is fixed by the deed to the property. The house was then heated by stoves and one winter was passed with that unsatisfactory system of heating. Following that experience, the furnace and the registers were installed. Surely, these facts would have been impressed upon their memories.

Further, there can be no question that Atherton made his first register, Defendant's Exhibit A, in the spring of 1923. He was, therefore, in possession of a register such as was installed in the Bossard home and was able to furnish the Bossard registers at the time the witnesses say they were installed.

The statement appearing at the top of page 26 and elsewhere in Plaintiff's Brief that the defence of prior public use rests upon nothing but oral testimony is unwarranted. Some of the indentical devices made, used and sold are in evidence. They are concrete things and are not oral testimony. Further, the deeds to the Bossard home and to the Atherton-Lindsay property are concrete things. They enable the witnesses to fix the dates of the installation at the Bossard home and of the exhibition of Atherton's first register to Lindsay as of a time more than two years prior to the filling date of the Carter application.

The Court cannot fail to find the defense of prior public use sustained without finding defendant's witnesses incapable of belief. As stated, the Bossards are entirely disinterested and they had no motive whatever for falsifying. Nothing whatever can be pointed to as even tending to impeach the testimony of Lindsay. He knows that he saw Defendant's Exhibit A, or one identically like it, in the early part of 1923, and he fixes the date by producing the deed to the factory site, which deed was obtained in 1923 after he had seen the said exhibit and because of it.

It is believed that the Court will not be impressed by the attack on Atherton's veracity. His testimony is clear cut and definite, and it is fully corroborated by his other witnesses. Although counsel for plaintiff asked witness after witness as to Atherton's general reputation for truth and veracity, no one would testify that it was bad except the bitterly hostile witness Chester.

Plaintiff's contention (Brief, pp. 27 to 29) that Bossard's testimony should be disregarded because he allegedly vio-

lated an ordinance of Los Angeles when he installed the Atherton registers in his home in 1923, is perhaps not worthy of comment. The contention is apparently based upon the legal maxim "He who comes into equity must come with clean hands."

It may be stated, however, that this maxim applies to one who comes into court asking some favor. If he comes without clean hands, he is in no condition to ask a favor of a court of equity. Bossard did not come into court asking for anything. He was merely a witness for defendant. Nor does defendant come into court asking for anything except that he be relieved from plaintiff's unjust charge of infringement. Therefore, the said maxim has no application in this case.

Further, it is to be presumed that the Bossard registers were legally installed. If there was an ordinance of the city of Los Angeles in 1923 which required a permit in order to place a furnace in a home already constructed, it was incumbent upon plaintiff to prove it. Not only was this necessary but it was incumbent upon plaintiff to show that that ordinance applied in the far-flung suburban towns, like Van Nuys, which were separated from the city proper by miles of intervening country. Further, it was incumbent upon plaintiff to show that the ordinance applied in the case of a sheet-metal worker and furnace man who, engaging in his daily trade, installed the register in his own home and at his own expense.

There being no testimony establishing any of these matters, the "clean hands" contention of plaintiff is clearly without merit.

Findings of Fact of District Court Made Upon Testimony Taken in Open Court Conclusive on This Appeal

It is settled law that a finding of fact of the District Court in equity will not be reviewed by the Appellate Court where, as here, the finding is made upon testimony taken in open court, unless there is manifest and palpable error in construing the testimony. The demeanor of a witness on the stand oftentimes speaks with greater force as to his honesty and credibility than the words uttered by him.

That this is the settled rule of this Court, appears from *Taylor v. Nevada Humbolt Tungsten Mines Company*, 295 Fed., 112, in which ^{it} was said:

“All the testimony in the case was taken before the court. The court had the opportunity to see and hear the witnesses and observe their demeanor. The opinion of the court shows that an exhaustive and careful re-veiw was had of all the voluminous testimony. Under those circumstances the finding of the court is final upon this appeal.”

In *Leggart v. McClure*, 234 Fed. 620, this Court again said:

“The findings of fact are all based upon evidence which is conflicting, and which was taken in open court, and they will not be disturbed by this court, in the absence of a showing that in arriving at the same, the court below erroneously applied some rule of evidence or found contrary to the decided weight of the testimony.”

Again, in *Gila Water Company v. International*, 13 Fed. (2nd), 1, this Court, speaking by his Honor Judge Rudkin, said:

“The findings below were based upon testimony taken in open court, and such findings will not be reviewed by an appellate court, except for plain or obvious error.”

Again, in *Tobey et al, v. Kilbourne et al*, 222 Fed. 760, this Court, speaking by his Honor Judge Gilbert, said:

“It is the established rule that the findings of the trial court in a suit in equity must be taken as presumptively correct, and that unless an obvious error has intervened in the application of the law, or some serious or important mistake has been made in the consideration of the evidence, the findings will not be disturbed by the appellate court. This rule is especially applicable in a case in which, as here, the testimony was taken in open court, where the trial court had the opportunity to observe the demeanor of the witnesses and their manner of testifying.”

Even the Supreme Court of the United States, in *Butte & Superior Copper v. Clark, etc.*, 249 U. S. 12, on an appeal from this Circuit Court of Appeals, and speaking with approval of the decision written by his Honor Judge Gilbert of this Court, said:

“We have examined the records sufficiently to see that the findings are all supported by the credible testimony of reputable witnesses. Upon settled principles which this court has always recognized, findings so made upon conflicting testimony are conclusive upon this appeal. . . . If the testimony does not show it (the conclusion of the court) is correct, it fails to show that it is wrong, and under those circumstances we are not justified in disturbing that conclusion. It

is our duty to accept a finding of fact, unless clearly and manifestly wrong.”

The rule of the Circuit Court of Appeals of the Ninth Circuit being thus made clear, it is submitted that the findings of fact of the trial Judge in the present case is conclusive upon this appeal.

Invalidity of Claims of Patent in Suit

It having been established that the registers complained of had been on the market and in public use for more than two years prior to the filing of the Carter application for the patent in suit, it necessarily follows that the claims of that patent cannot be construed so broadly as to cover those old registers without invalidating the claims. Clearly, Atherton has a right to continue doing the things which he began in 1923 without interference from Carter or from plaintiff. As has been pointed out, the claims call for the rods extending across the opening in the frame and for the shoulders on the shutters to form limiting stops by engagement with the shutter connecting bar. These features Atherton never has used, and they were not present in his old registers. If the claims be given their proper scope, they may be valid notwithstanding plaintiff's present contention that these features are immaterial; but if the said features be disregarded, then the claims read directly upon the old Atherton registers and are fully anticipated by them.

Claims of Carter Patent Are for Aggregations

In Defendant's Answer, Paragraph XIII, it was averred that the claims of the patent in suit are void as being for mere aggregations and not for patentable combinations. That is a question of law and, of course, no testimony respecting the same was adduced. No ruling upon this question was made by the trial court; but it is part of defendant's

case and defendant has a right to have it considered upon this appeal. It is a matter which appears upon the face of the patent itself, and the Court of Appeals could take judicial notice of it even if it had not been pleaded. But it was pleaded; and

“All issues presented by the pleadings and evidence are before the Circuit Court of Appeals for adjudication on appeal from the district court.” *Lyon v. Union Gas and Oil Company*, 281 Fed., 674.

The principle underlying the doctrine of aggregation can best be set forth by an illustration.

In the issue of about May 8, 1929, of the *Los Angeles Examiner*, the cartoonist Goldberg depicted what he termed “The Complete Radio Set.” At one end of the cartoon it is stated:

“People are not satisfied with plain radio sets anymore. They want them to contain bookcases, humidors, writing tables and other combinations of household furniture. Here is the all-satisfying radio set of the future.”

The cartoonist then pictures what is substantially a modern cabinet radio on the top of which he mounts a pigeon house. On the left hand side he has attached to the cabinet a bed to which there is connected an exercise machine with an automatic cocktail shaker. On the other side of the radio cabinet there is an umbrella stand and golf bag and a lawn with a chicken and a lawn-mower thereon, the lawn being upon a platform which is connected with the radio cabinet. On the far end of the lawn is a dog-house with a ladder, and a tree is shown growing out of the top of the dog-house. At the side of the platform for the lawn is a folding bridge table.

This is an ideal illustration of the principle of aggregation. It is safe to say that no such an assemblage of elements or features had ever been brought together before; and yet there is nothing patentable in this assemblage because the various elements thereof are completely independent and unrelated. They have no conjoint action and the operation or use of one of them can in no wise affect the operation of the other. That is characteristic of aggregations as contrasted with patentable combinations. To make up a patentable combination it is necessary that the various elements co-act so as to produce some new and unitary result. This is clearly expressed by the Supreme Court of the United States in the case of *Hailes v. Van Wormer*, 87 U. S. 353, wherein it is stated:

“It must be conceded that a new invention, if it produces new and useful results, is patentable, tho all the constituents of the combination were well known and in common use before the combination was made. But the results must be a product of the combination and not a mere aggregate of several results each the complete product of one of the combined elements Merely bringing old devices into juxtaposition, and then allowing each to work out its own effect without the production of something novel is not invention.”

Applying the above illustration and decision to this case, we find that claim 1 of the Carter patent calls for

1. The equi-distant rods extending across the opening of the rectangular frame.
2. The arrangement of the rolled edge of one shutter

and the offset edge of the adjacent shutter so as to present a panel effect when the shutters are closed and a fixed bar design when the shutters are open.

3. The construction of the corner portion of each shutter so as to form an ear and the bar connecting the ears.

4. The shoulders which are formed when the ears are produced, which shoulders are engageable by the bar to limit the opening movement of the shutters.

Now, as to the structure and arrangement of the edges of the shutters to present a panel effect, it seems clear that it can make no possible difference whether the rods extend across the opening or not. In fact, it is to be remembered that neither plaintiff nor defendant uses the rods across the opening, which is, in itself, clear proof that there is no interdependence or cooperation between these two features. Neither can it make any difference to the structure of the ends of the shutters comprising the slit, the ears and the connections with the operating bar whether the rods extend entirely across the opening. Neither can it make any difference to that feature which calls for the shoulders forming the limited stop for the shutters whether the rods extend entirely across the opening. Nor can it make any difference to that feature at the ends of the shutters comprising the ears and the pivotal connections with the operating bar whether the shutters close to produce a panel effect and open to produce a bar effect. Nor can it make any difference to any of the features above enumerated whether the shoulders engage the bar to limit the opening movement of the shutters.

What is true of claim 1 is likewise true of claim 2.

From the above analysis of the claims it is clear that the various elements or features which are recited in the

claims do not cooperate to produce any unitary result. The presence of one of them makes no difference to the operation of the others. There is no unitary result that is attained by bringing all of the features of the claims into juxtaposition any more than there is in the various features of Goldberg's ideal radio set. Therefore, the claims of the patent should be declared invalid on the ground that they are for mere aggregations of independent and unrelated elements and are not for combinations in which the elements are related and which cooperate to produce some unitary result. The results of the assemblage is the "mere aggregate of several results each the complete product of one of the combined elements." (*Hailes v. Van Wormer*, supra).

CONCLUSIONS

It is, therefore, submitted that the court should find that:

1. The defendant, Charles Atherton, has not infringed the claims of the patent in suit or either of them;
2. The registers complained of have been in public use and on sale in the United States from a time more than two years prior to the filing of the application upon which the patent in suit was granted.
3. If the claims of the patent be construed so broadly as to cover the register of the defendant Atherton, they are invalid because of said prior public use and sale.
4. The claims of the patent in suit are invalid as being for mere aggregations of independent and unrelated elements and not for patentable combinations.
5. The decision of the District Court should be affirmed.

Respectfully submitted,
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